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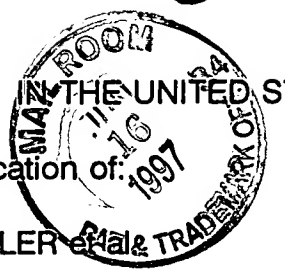


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Rudolf RIGLER et al.

App. No: 08/491,888 Group Art Unit: 1818

Filed: July 18, 1995 Examiner: H. Bakalyar

For: A METHOD AND A DEVICE FOR THE EVALUATION OF BIOPOLYMER FITNESS

RESPONSE

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

The instant response is submitted to the Office action mailed April 15, 1997.

Restriction under PCT Article 17(3)(a) is, allegedly, required. Applicants elect the claims of Group I, claims 1-46 and 69, with traverse. Traverse is maintained because PCT Article 17(3)(a) does ***not*** support the restriction.

PCT Article 17(3)(a) permits the national examination authority to withdraw from examination "those parts of the ***international*** application which . . . have not been searched" [***emphasis added***]. In the present case, claims 1-65 and 69-84 of the international application ***were searched*** by the international authority [International Preliminary Examination Report, Box 4, ¶4]. Therefore, ***under PCT Article 17(3)(a)***, applicants are entitled to have claims 1-65 and 69-84 examined.

Election of species is, allegedly, required under PCT Rules 13.1 and 13.2; to one of species I-IV set forth in the Office action. Applicants elect species III, with traverse. Traverse is maintained because neither PCT Rule 13.1 nor PCT Rule 13.2 supports or authorizes ***any*** election-of-species requirement; let alone the particular election

requirement set forth in the Office action.

PCT Rules 13.1 and 13.2 relate to the same unity-of-invention concept of PCT Article 17(3)(a), discussed above. The examiner has designated (albeit, incorrectly) claims 1-46 and 69 (Group I) as forming a single inventive concept under PCT Article 17(3)(a). Further limiting examination (to a "species," or anything else) ***within*** this single inventive concept is not authorized under the PCT Articles or Rules.

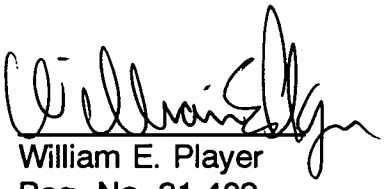
In fact, the PCT Rules implicitly prohibit an election-of-species requirement. Species I-IV relate to dependent claims. PCT Rule 13.4 states:

> Subject to Rule 13.1, it ***shall be permitted*** to include in the same international application a reasonable number of dependent claims, . . . ***even where . . . any dependent claim could be considered as constituting in themselves an invention***. [***Emphasis added***.]

Accordingly, the requirement for an election of species is improper, even if each of species I-IV constitutes, by itself, a separate invention.

Favorable action commensurate with the foregoing is requested.

Respectfully submitted,

By: 

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